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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,936	06/08/2000	Steve Lemke	PALM-2849	1836
7590	08/04/2004		EXAMINER ANDERSON, MATTHEW D	
Wagner Murabito & Hao LLP Third Floor Two North Market Street San Jose, CA 95113			ART UNIT	PAPER NUMBER
			2186	

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,936

Applicant(s)

LEMKE, STEVE

Examiner

Matthew D. Anderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 6-7, 9, 11, 14, 17, 19-20, 22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US Patent # 5,949,997) and Zaidi *et al.* (US Patent 6,542,981).

3. With respect to claims 1 and 14, Smith discloses:

a processor (item 14); a first memory (20) coupled to the processor for storing information that is required during startup of the computer system; and a second memory (22) coupled to the processor, for storing new information and capable of retaining information stored therein upon restart of the computer system, as shown in figure 1;

an I/O device couple to the processor for receiving new information intended for the first memory deice from an external source, as taught by the communications port in column 2, lines 30-40;

restarting the computer system without relying on the new information, as shown in figure 3, item 62;

verifying said new information stored in the second memory to ensure that it is safe to load said new information into said first memory, and responsive to the verifying, loading the new information from the second memory into the fist memory wherein the new information can

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be used for a subsequent startup of the computer system, by teaching in the abstract of performing diagnostics to verify that the updated program is operational, and if so, the program is used for further initial boots.

4. With respect to claims 4 and 17, Smith discloses performing a checksum test of the new information in said second memory to ensure that said new information is free from corruption, as recited in column 2, line 54.

5. With respect to claims 6 and 19, Smith discloses the first memory comprising a flash ROM, as shown in figure 1, item 20.

6. With respect to claims 7 and 20, Smith discloses the new information comprising boot ROM code, by teaching in column 6, lines 55-60, that the microprocessor is booted using the stored program.

7. With respect to claims 9 and 22, Smith discloses the first memory having no information stored therein initially, because it would be inherent that at some point during manufacture that the memory would contain no information.

8. With respect to claims 1, 11, 14, and 24, Smith, while showing switching flash banks to the updated boot code, does not specifically teach of a handheld computer system, loading the new information from the second memory to the first memory to be used for subsequent startups, or of receiving new information via wireless communication. Zaidi *et al.* teach in figures 1-3, of installing a microcode upgrade from a nonvolatile storage medium such as a floppy disk into the nonvolatile memory area 100 of the system in figure 1 for future reboots, and in column 3, lines

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30-31, gives examples of their invention including handheld computers and wireless communication.

9. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith and Zaidi *et al.* before him at the time the invention was made, to modify the boot code update taught by Smith, to load the update from a second memory, as with the boot code update of Zaidi *et al.*, in order update the system if it becomes outdated or defective, as taught by Zaidi *et al.*.

10. Claims 2, 8, 10, 15, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Zaidi *et al.*, and Tamori *et al.* (US Patent # 5,960,445).

11. With respect to claims 2 and 15, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose the step of copying existing information in the first memory to the second memory such that the existing information can be restored into the first memory should the first memory become corrupted. Tamori *et al.* teach in figure 10 of copying the current BIOS to the external RAM.

12. With respect to claims 8 and 21, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose the new information comprising operation system code. Tamori *et al.* teach in column 5, lines 30-31, of the BIOS code being control programs in the OS.

13. With respect to claims 10 and 23, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose the second memory being a RAM. Tamori *et al.* teach this in figure 10-18.

14. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Zaidi *et al.*, and Tamori *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith and Zaidi *et al.*, to include the copying of existing version to external storage, OS code, and RAM, as with the boot program update of Tamori *et al.*, in order to provide failure recovery during the boot program update process, as taught by Tamori *et al.*.

15. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Zaidi *et al.*, and Hill *et al.* (US Patent # 5,987,605).

16. With respect to claims 3 and 16, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose checking the version date of the new information in the second memory to ensure compatibility. Hill *et al.* teach in column 7, lines 42-46, of using version information to determine if the boot memory devices are inconsistent.

17. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Zaidi *et al.*, and Hill *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith and Zaidi *et al.*, to include the version checking, as with the boot program update of Hill *et al.*, in order to assure consistency, as taught by Hill *et al.*.

18. Claims 5 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Zaidi *et al.*, and Lim (US Patent # 6,138,233).

19. With respect to claims 5 and 18, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose checking a power level to ensure the loading

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can be completed without power failure. Lim teach in column 4, lines 20-23, of updating the BIOS only when the battery level exceeds a certain threshold.

20. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Zaidi *et al.*, and Lim before him at the time the invention was made, to modify the boot program update taught by Smith, to include the power level checking, as with the boot program update of Lim, in order to assure update completion, as taught by Lim.

21. Claims 12 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Zaidi *et al.*, and Pierre-Louis *et al.* (US Patent # 6,421,777).

22. With respect to claims 12 and 25, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, but does not specifically disclose the computer system being a PDA. Pierre-Louis *et al.* teach in column 5, line 3, of the client system being a PDA.

23. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Zaidi *et al.*, and Pierre-Louis *et al.* before him at the time the invention was made, to modify the boot program update taught by Smith and Zaidi *et al.*, to include a PDA client, as with the boot program update of Pierre-Louis *et al.*, in order to provide handheld computing, as taught by Pierre-Louis *et al.*.

24. Claims 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith, Zaidi *et al.*, Pierre-Louis *et al.*, and Theimer *et al.* (US Patent # 6,421,777).

25. With respect to claims 13 and 26, Smith and Zaidi *et al.* disclose all other limitations, as discussed above, while Pierre-Louis *et al.* teach such a boot program update system in a PDA,

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but does not specifically disclose the external source being a PDA. Theimer *et al.* teach in column 5, line 3, of transferring files between PDAs.

26. It would have been obvious to one of ordinary skill in the art, having the teachings of Smith, Zaidi *et al.*, Pierre-Louis *et al.*, and Theimer *et al.* before him at the time the invention was made, to modify the boot program update in a PDA taught by Smith, Zaidi *et al.*, and Pierre-Louis *et al.*, to have the update boot program file be transferred via another PDA as in Theimer *et al.*, in order to provide multicomputer handheld communication, as taught by Theimer *et al.*.

Response to Amendment

27. In response to the amendment filed 6/24/04: claims 1, 5, 12, and 14-26 have been amended.

Response to Arguments

28. With respect to claims 1 and 14, and in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). And in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

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5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, it is the combination of the of Smith and Zaidi teach the verifying and loading steps in order to provide upgradeability in the computer system by updating the microcode, as taught in column 1 of Zaidi.

Conclusion

29. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar boot program update systems.

30. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Anderson whose telephone number is (703) 306-5931. The examiner can normally be reached on Monday-Friday, 2nd Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (703) 305-3821. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew D. Anderson
July 28, 2004